

Application No.: 10/685,406
Art Unit: 3722

Attorney Docket No. 23380.00
Confirmation No. 7856

REMARKS

Claims 1- 6, 8, 9 and 11-17 remain pending in the present application. Claim 1 is an independent claim. The claims presently under consideration are the same versions as those presented in Applicant's communication filed on August 13, 2004.

In the Final Office Action, the Examiner rejected Claims 1-6, 8, 9 and 10-17 under 35 U.S.C. § 103(a) as being unpatentable over Rosen (U.S. Patent No. 5,987,825) in view of Kim (U.S. Patent No. 5,123,191). It is apparent that the Examiner did not intend to include Claim "10" under the instant rejection since this claim was canceled by the prior amendment. Claim 8 was further rejected U.S.C. § 103 (a) as being unpatentable over Rosen in view of Kim, and further in view of Selman (U.S. Patent No. 4,852,282). These grounds of rejection are respectfully traversed for the reasons as set forth of record and as delineated herein below.

The Examiner's contention that Rosen discloses the claimed invention except for the specific arrangement and/or content of the indicia is not supported by the realistic teachings afforded by the primary reference. The Rosen patent discloses a modular message center having a main module and a supplemental module. A frame member divides the main module into a first area and a second area. The first area includes an attachment device and is dimensioned to hold a calendar. The second area on the main module is a cork board. Fig. 4 shows the main module holding a prefabricated single year calendar that displays one calendar month at a time, while Fig.

Application No.: 10/685,406
Art Unit: 3722

Attorney Docket No. 23380.00
Confirmation No. 7856

5 shows the main module holding a prefabricated single year calendar that displays two successive months at a time. After the month and year expires, a new calendar must be furnished for use with the modular message center. The supplemental module also has multiple areas divided and defined by a frame. One area is a dry-erase board, a second and third area is dimensioned to hold accessory articles such as an eraser and a pad of notes.

In contrast to the modular message device taught by Rosen, Applicant's claimed invention is a single sheet twelve-month chart joined to a monthly calendar. The chart has been prefabricated to display imprinted rows and columns that define a plurality of memorandum spaces for permanently recording events and the calendar has been pre-fabricated to display imprinted rows and columns that define a plurality of memorandum spaces for temporarily recording events. A protective transparent cover is removably disposed over the single sheet twelve-month chart. Applicant's invention is used perennially since information can be added to the single sheet twelve-month chart and the calendar can be updated as one month expires. Clearly, the birthday calendar set forth by the present claims is structurally and functionally unrelated to the message center taught by Rosen.

In order to supplement the apparent deficiencies of the primary reference to Rosen, the Examiner relies upon the secondary reference to Kim. The patent to Kim discloses a wall and desk calendar display device that combines a prefabricated calendar with a calendar frame. Kim's transparent cover includes a transparent vinyl back pocket cover (22), a transparent vinyl front

Application No.: 10/685,406
Art Unit: 3722

Attorney Docket No. 23380.00
Confirmation No. 7856

cover (15) extending from a transparent vinyl top cover (16). The transparent vinyl top cover (16) forming a pocket for tightly inserting an upper end of a calendar pad thereinto. Applicant's transparent cover is removably disposed over and protects the single sheet twelve-month chart. The Examiner's combination of Kim with Rosen is unwarranted since there exists no motivation for combining the transparent cover of Kim with a message module center of Rosen

It should be noted that obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987). Further, the Federal Circuit in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999) deprecated rejections based upon "a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The Court said that "the showing must be clear and particular" and that broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis".

Application No.: 10/685,406
Art Unit: 3722

Attorney Docket No. 23380.00
Confirmation No. 7856

As this court has stated, "virtually all [inventions] are combinations of old elements." (*citations omitted*). ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensoronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. (*Emphasis added*).

In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998) at 1457-58.

Applicant contends that one skilled in the art would not be motivated to combine the references in the manner suggested by the Examiner. Applicant further contends that even if the references were properly combinable, the above noted deficiencies of the primary reference to Rosen are not remedied by the teachings afforded by the secondary reference to Kim. Thus, one of ordinary skill in the art without the benefit of Applicant's own disclosure would not be capable

Application No.: 10/685,406
Art Unit: 3722

Attorney Docket No. 23380.00
Confirmation No. 7856

of arriving at the presently claimed invention by combining the references in the manner suggested by the Examiner since none of references cited or applied of record realistically suggests the essential combination of features that forms the basis of the instant claims. For at least these reasons, Applicant respectfully submits that independent Claim 1 and corresponding dependent Claims 2-6, 8-9 and 11-17 are allowable over the prior art of record.

Applicant further contends *In re Gulack*, 217 USPQ 401, (CAFA 1883), cited of record, does not support the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art to provide any desired indicia on the calendar and erasable surface. As noted of record by Applicant, *In re Gulack* cites that "differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole." *In re Gulack*, 217 USPQ 403.

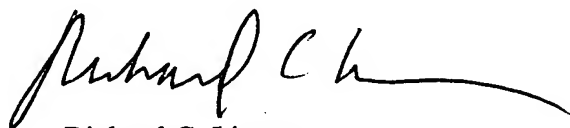
Applicant respectfully submits that the present Response properly responds to the outstanding Final Rejection. This proposed Response does not raise any new issues and is a *bona fide* effort to satisfactorily conclude the prosecution of this application. It is felt that no inordinate amount of time will be required on the part of the Examiner to review and consider this Response. In the event that an appeal is filed, it is requested that this Response be entered for purposes of appeal.

Application No.: 10/685,406
Art Unit: 3722

Attorney Docket No. 23380.00
Confirmation No. 7856

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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RCL:DHT/lxb